

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 39-61 are pending. In the present amendment, Claims 39, 45, and 51 are currently amended. Support for the present amendment can be found in the originally filed specification, for example, at page 10, lines 2-9 and 18-25, at page 12, lines 6-11, and at page 12, line 21 to page 13, line 2. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claim 45 was rejected under 35 U.S.C. § 102(b) as anticipated by Honda (U.S. Patent No. 4,589,432); Claims 39, 40, 43, 44, 51-54, 57, and 58 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson (U.S. Patent No. 3,645,835); Claims 45, 46, 50, and 61 were rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin (U.S. Patent No. 4,653,483); Claim 47 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Samuelsen et al. (WO 99/38929, hereinafter “Samuelsen”); Claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Hodgson; and Claims 59 and 61 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson in view of Berglund et al. (U.S. Patent No. 4,310,509, hereinafter “Berglund”).

In response to the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of these rejections and traverses these rejections, as discussed below.

The independent claims are hereby amended to better clarify the relationship between the resilient shrinkability of the string member and the adhesiveness of the adhesive layer. Specifically, an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled

back toward the unstretched state to form the double eyelid. Thus, the string member has a resilient shrinkability that is larger than a tension of the eyelid such that a portion of the eyelid can brake from the eyeball to form the fold and the adhesive layer has a sufficient adhesive strength to maintain its grip on the eyelid while the string member is recoiled back to its non-stretched state. It is respectfully submitted that the cited references do not disclose or suggest every feature recited in the independent claims.

Honda describes an eyelash permanent curl setting rod 1 including a rod member 2 and an adhesive layer 3 on a periphery of the rod member 2.<sup>1</sup> Further, the rod member 2 described in Honda adheres to leading ends of eyelashes such that the *eyelashes* (not the eyelid) are curled around the rod member 2 which is then adhered to the eyelid of the user.<sup>2</sup> Thus, although Honda describes that the rod 1 includes an elastic rod member 2 and an adhesive 3, Honda does not disclose or suggest that the adhesive 3 is strong enough to hold on to the skin when the stretched rod 1 is attached to the skin and then allowed to recoil back to an unstretched state. Instead, Honda only describes that the adhesive 3 is strong enough to hold on to the eyelash and the eyelid in an unstretched state.

Although Claim 45 is directed to a double eyelid forming article of manufacture, and thus does not positively claim an eyelid of a user, the claim language does require the article of manufacture to have certain structural properties (including resilient shrinkability and adhesiveness) that dictate how the article of manufacture interacts with an eyelid. Accordingly, although Honda does not have to specifically disclose that the rod 1 is in contact with the skin of an eyelid, the article in Honda would have to interact in the claimed manner with the skin of an eyelid. Thus, it is again noted that Honda does not disclose or suggest that the elastic material of the rod 1 described in Honda has a resilient shrinkability

---

<sup>1</sup> See Honda, at column 2, lines 18-23 and in Figure 1.

<sup>2</sup> See Honda, at column 3, lines 3-15.

larger than a tension of the skin on the eyelid as Honda does not disclose or suggest stretching the rod 1 and then attaching the rod 1 to the eyelid.

Accordingly, the position taken in section 6 on page 4 of the Office Action that “the structures of Honda and Applicant’s string member are structurally same” is without support and should be withdrawn. Specifically, the rod 1 of Honda can perform its intended function (curling an eyelash) without having the structural configuration to perform any of the functions of the claimed double eyelid forming article. Further, although the rod 1 of Honda may be stretchable, there is no evidence that the rod 1 could be stretched, attached to an eyelid (not eyelash), and then remain attached to the eyelid while the resilient shrinkability of the rod 1 overcomes the tension of the skin on the eyelid to break the eyelid from the eyeball to form the fold.

Additionally, in view of the claim amendments discussed above which further define the relationship between the resiliency of the string member and the adhesiveness of the adhesive layer, as the relationship between the resiliency of the string member and the strength of the adhesive of the claimed article are not disclosed or suggested in Honda, Applicant again respectfully submits that the rod 1 of Honda does not have the same structural configuration of that recited in Claim 45.

Accordingly, it is respectfully submitted that Honda does not disclose or suggest every feature recited in Claim 45. Thus, it is respectfully requested that the rejection of Claim 45 as anticipated by Honda be withdrawn.

Hodgson describes a surgical drape including a backing material 2 and an adhesive 4.<sup>3</sup> Further, Hodgson describes that the surgical drape may also be used for other purposes such as applying cosmetics or to produce a wrinkle in the skin.<sup>4</sup>

---

<sup>3</sup> See Hodgson, at column 10, lines 27 and 28 and in Figure 7.

<sup>4</sup> See Hodgson, at column 10, lines 32-40.

Regarding the position taken in section 9 on page 5 of the Office Action that certain claim elements are intended use, Applicant notes that the functions recited require a particular structural configuration. Specifically, as recited in amended Claim 39, “an entirety of the adhesive layer has an adhesiveness sufficient to prevent the tape member from being detached from adhering portions on the skin on the eyelid when the tape member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the unstretched state to form the double eyelid.” Thus, the claimed tape member has a resilient shrinkability that is larger than a tension of the eyelid such that a portion of the eyelid can brake from the eyeball to form the fold and the adhesive layer has a sufficient adhesive strength to maintain its grip on the eyelid while the string member is recoiled back to its non-stretched state.

Although Hodgson describes producing a wrinkle on skin, Hodgson is silent with respect to producing a double eyelid on the skin of an eyelid. Further, the surgical drape described in Hodgson can produce a wrinkle for example, on a forearm, without producing a double eyelid on the skin of the eyelid. Thus, Hodgson does not inherently have the same structural properties of resilient shrinkability and adhesiveness that the claimed double eyelid forming article does.

Although the Office Action in section 15 on page 8 takes the position that “[i]t is reasonable to presume that the adhesive tape member of Hodgson has the properties of ‘resilient shrinkability’ and sufficient width and a sufficient length for forming the fold,” Applicant respectfully disagrees with this assertion. On the contrary, as discussed above, the surgical drape described in Hodgson is capable of performing all of the functions described in Hodgson without being functionally capable of meeting the recitations of Claim 39. Thus, the Office Action does not cite any evidence from Hodgson as the basis for the reasons it presumes that the surgical drape of Hodgson can form the claimed fold of the eyelid. Although the Office Action states that “the adhesive tape members of Hodgson and that of

Applicant have similar structure and composition,” the Office Action has not cited any evidence in Hodgson, that it has a shrinkability that can break the eyelid from the eyeball while maintaining its adhesive grip on the skin of the eyelid to form the double fold.

Hodgson describes forming a wrinkle on the skin; but no evidence has been provided that the same resilient shrinkability to form a wrinkle on the arm would also form a wrinkle on the eyelid. Thus, a person of ordinary skill in the art reading Hodgson would not reasonably understand that the surgical drape of Hodgson could form the double eyelid.

Accordingly, it is respectfully submitted that Hodgson does not disclose or suggest every feature recited in Claim 39. Thus, it is respectfully requested that the rejection of Claim 39, and all claims dependent thereon, as unpatentable over Hodgson be withdrawn.

Further, independent Claims 45 and 51, while directed to alternative embodiments, each recite features similar to those discussed above with respect to Hodgson. Thus, it is also respectfully requested that the rejection of Claims 45 and 51, and all claims dependent thereon, as unpatentable over Hodgson be withdrawn.

Clavin describes an adhesive strip 32 configured to hold the skin of the upper eyelid 10 which is pulled gently down over the adhesive strip 32 to reduce bagging of the upper eyelid 10.<sup>5</sup> Accordingly, the adhesive strip 32 described in Clavin is first placed on the eyelid 10, and then a user folds the eyelid 10 over the adhesive strip 32.

Clavin is silent with regard to first stretching the strip 32, and then allowing the resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the strip 32 returns to its original size. Although Clavin describes that the adhesive strip 32 can be formed of polyethylene, it is noted that there are many different types of polyethylene with different structural properties such that the adhesive strip 32 does not inherently have resilient shrinkability larger than a tension of the skin. Instead, unlike the

---

<sup>5</sup> See Clavin, at column 4, lines 26-35 and in Figures 6-9.

claimed tape member, the polyethylene described in Clavin is not required to have resilient shrinkability. Thus, while the claimed string member has a specific resilient shrinkability, the adhesive strip 32 of Clavin can perform its intended functions without having the same resilient shrinkability.

Further, it is noted that an increased force would be placed on the adhesive layer during shrinking as compared to the adhesive strip 32 of Clavin, which has the skin folded to it. Thus, there is no disclosure in Clavin that the adhesive on the strip 32 could hold onto the skin during the shrinking.

Independent Claim 45 also recites that “the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the string member when the string member is in the unstretched state, cross sections of the first surface and the second surface perpendicular to the longitudinal direction of the string member each have outwardly protruding arcuate shapes along the entire longitudinal direction of the string member when the string member is in the unstretched state, the cross sections each have a uniform form along the whole longitudinal direction of the string member when the string member is in the unstretched state.”

The Office Action in section 23 takes the position that certain elements in Claim 45 are disclosed in Figures 13 and 15 of Clavin or are an “obvious optimization to one of ordinary skill in the art, motivated by the desire to produce a string member that can be suitably applied to eyelids.” Applicant again respectfully traverses this assertion.

On the contrary, in the double eyelid forming product of the type to simply stick as described in Clavin, a person of ordinary skill in the art reading Clavin would understand that it is necessary to stick the tape to the eyelid along the three-dimensional shape of the eyeball. Thus, a curve of at least a portion of the side edges is an indispensable requirement in Clavin and the tape with linear side edges entirely parallel to each other is not a part of the double

eyelid forming product. Accordingly, a person of ordinary skill in the art reading Clavin would not find it obvious to optimize the adhesive strip 32 to have the claimed dimensions.

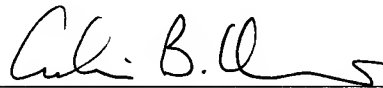
Therefore, it is respectfully submitted that Clavin does not disclose or suggest every feature recited in independent Claim 45. Thus, it is respectfully requested that the rejection of Claim 45, and all claims dependent thereon, as unpatentable over Clavin be withdrawn.

Turning now to the rejections of Claims 47, 49, 59, and 61, it is noted that these claims are dependent on independent Claims 39, 45, and 51. Accordingly, these claims are believed to be patentable for at least the reasons discussed above with respect to Claims 39, 45, and 51. Further, it is respectfully submitted that none of the secondary references (Samuelson, Hodgson, and Berglund) cure the above-noted deficiencies of Clavin and Hodgson. Thus, it is respectfully requested that the rejections of Claims 47, 49, 59, and 61 be withdrawn.

Consequently, in view of the above discussion, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, L.L.P.



\_\_\_\_\_  
Gregory J. Maier  
Attorney of Record  
Registration No. 25,599

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 07/09)

Colin B. Harris  
Registration No. 58,969